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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/411,418	10/01/1999	JOHN A. CAREY	99-TK-257	8281

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EXAMINER

DAY, HERNG DER

ART UNIT PAPER NUMBER

2128

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/411,418

Applicant(s)

CAREY, JOHN A.

Examiner

Herng-der Day

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's Amendment and Response ("Amendment") to Office Action dated June 3, 2004, mailed September 3, 2004, and received by PTO September 10, 2004.

1-1. Claims 1-5, 7, 13, 17-19, and 25 have been amended. Claims 1-20 and 25 are pending.

1-2. Claims 1-20 and 25 have been examined and rejected.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 and 25 are rejected under 35 U.S.C. 101 because the inventions as disclosed in claims are directed to non-statutory subject matter.

3-1. Claims 1-12 and 25 claim a method and claims 13-20 claim a model. However, none of the claims is tangibly embodied because it could be practiced with pencil and paper. In other words, it is not in the technology arts.

3-2. The claimed invention of claims 1-12 and 25 does nothing more than manipulating program parameters. In other words, it has no practical application in that the method mere defines parameters without defining a concrete, useful, and tangible result.

Allowable Subject Matter

4. Claims 1-20 and 25 are not taught by the prior art, and would be allowable if the above rejection under 35 U.S.C. 101 is overcome.

Applicant's Arguments

5. Applicant argues the following:

5-1. Rejections under 35 U.S.C. 112

(1) The amendments to claims 1-4, 13, 17, 19, and 25 are believed to overcome the 112 rejections (page 7, paragraphs 2-4, Amendment).

5-2. Rejections under 35 U.S.C. 101

(2) "The degree to which the actions performed in claims 1-12 and 25 are performed by a computer or a machine or a person are not specified in the claims. Accordingly, it is respectfully believed that claims 1-12 and 25 call for a sets of actions that define a method that is statutory subject matter under 35 U.S.C. 101" (page 8, paragraph 1, Amendment).

(3) "Claims 13-20 call for various 'models' that can be thought of as data structures or representations that are used in the design of an integrated circuit. Data structures are patentable subject matter under 35 U.S.C. 101" (page 8, paragraph 2, Amendment).

5-3. Double Patenting

(4) "A terminal disclaimer to overcome the double patenting rejection will be submitted upon indication of allowable subject matter" (page 8, paragraph 4, Amendment).

5-4. Rejections under 35 U.S.C. 102

(5) Claimed inventions are not shown or suggested in the McGeer reference (pages 8-12, Amendment).

Response to Arguments

6. Applicant's arguments have been fully considered.

6-1. Applicant's argument (1) is persuasive. The rejections of claims 1-4, 13-20, and 25 under 35 U.S.C. 112 have been withdrawn.

6-2. Applicant's arguments (2) and (3) are not persuasive. First, Claims 1-20 and 25 are not in the technology arts. Second, each of the claimed invention of claims 1-12 and 25 has no practical application in that the method mere defines parameters without defining a concrete, useful, and tangible result. Third, data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

6-3. Response to Applicant's argument (4). Double Patenting rejection will be withdrawn after a terminal disclaimer has been received.

6-4. Applicant's argument (5) is persuasive. The rejections of claims 1-20, and 25 under 35 U.S.C. 102(e) have been withdrawn.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jean R. Homere can be reached on (571) 272-3780. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day *HD*
December 26, 2004

Thai Phan
Thai Phan
Patent Examiner
AU: 2128